

REMARKS

I. Introduction

In response to the Office Action dated October 1, 2003, claims 32 and 42 have been amended. Applicants respectfully acknowledge the Examiner's allowance of claims 36-44.

Claims 32-44 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Claim Amendments

Applicants' attorney has made amendments to claims 32 and 42 as indicated above. In view of the Examiner's comments at page 4, first full paragraph, claim 32 has been amended so that the compound having the formula recited in the preamble is further recited in this claim in a manner that clarifies it as a point of distinction. Claim 42 has been amended to delete the comma between the terms "cellulose" and "acetate". This amendment to claim 42 corrects a typographical error and conforms the language in this claim to that found in Applicants' specification as filed, for example at page 20, lines 12-14. These amendments to the claims introduce no new matter.

III. Double Parenting Rejections

On page (2) of the Office Action, claims 32-35 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,777,060. Also on page (2) of the Office Action, claims 32-35 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,786,439. On page (3) of the Office Action, claims 32-35 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-35 of copending Application No. 10/213,265.

As noted above, Applicants have amended claim 32 so that it clearly recites a method that includes the step of admixing the compound of Formula I with a diisocyanate and a hydrophilic polymer, wherein said hydrophilic polymer is a member selected from the group consisting of a hydrophilic polymer diol, a hydrophilic polymer diamine and combinations thereof, wherein said diisocyanate comprises about 50 mol% of the reactants in said admixture to form said biocompatible polymer matrix.

The claims 1-19 of U.S. Patent No. 5,777,060, claims 1-9 of U.S. Patent No. 5,786,439 and claims 16-35 of copending Application No. 10/213,265 fail to teach or suggest compositions that include the compound of Formula I. For this reason, Applicants respectfully request the withdrawal of the outstanding obviousness-type double patenting rejections.

IV. Prior Art Rejections

On pages (3)-(4) of the Office Action, claims 32-35 were rejected under 35 U.S.C. §102(b) as being anticipated by Gould et al., U.S. Patent No. 5,334,691 (Gould). Also on page (4) of the Office Action, claims 32-35 were rejected under 35 U.S.C. §102(b) as being anticipated by Hoy et al., U.S. Patent No. 4,209,605 (Hoy) and Hudgin et al., U.S. Patent No. 3,975,350 (Hudgin).

As noted above, Applicants have amended claim 32 so that it clearly recites a method that includes the step of admixing the compound of Formula I with a diisocyanate and a hydrophilic polymer, wherein said hydrophilic polymer is a member selected from the group consisting of a hydrophilic polymer diol, a hydrophilic polymer diamine and combinations thereof, wherein said diisocyanate comprises about 50 mol% of the reactants in said admixture to form said biocompatible polymer matrix.

The disclosures in Gould et al., Hoy et al., and Hudgin et al., fail to teach or suggest compositions that include the compound of Formula I. For this reason, Applicants respectfully request the withdrawal of the outstanding rejections under 35 U.S.C. §102(b).

Thus, Applicants submit that independent claim 32 is allowable over these references. Further, dependent claims 33-35 are submitted to be allowable over these references in the same manner, because they are dependent on independent claim 32, and thus contain all the limitations of the independent claims. In addition, dependent claims 33-35 recite additional novel elements not shown by these references.

V. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date:

By:

Name: William J. Wood

Reg. No.: 42,236

wjw/

G&C 130.24-US-C1